IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD THE PATENT APPEALS AND INTERFERENCES

Application of

Applicants	:	Vidler et al
Serial No.	:	10/822,386
Filed	:	April 12, 2004
Title	:	DATA CARRIER FOR HEALTH RELATED INFORMATION
Docket	:	STD 1222 PA/41213.596
Examiner	:	Jamila O. Williams
Art Unit	:	3722
Conf. No.	:	2855

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

This Reply Brief is submitted in response to the Examiner's Answer of July 10, 2008, and concurrently with the submission of a Request for Oral Argument. This Reply Brief was necessitated by the Examiner's incorrect treatment of Federal Circuit case law in the Examiner's Answer, as explained below, and is fully in compliance with 37 CFR §41.41.

Attention is directed to the Examiner's treatment of *In re Gullack* and *In re Ngai* on pages 8 and 9 of the Examiner's Answer. The Examiner has cited *In re Gullack*, 217 USPQ 401 (Fed.Cir. 1983) and relies upon this case to assert that there is no functional relationship between the claimed printed matter and the balance of the claimed elements, and that therefore any change in the position or content of the printed matter of the Blank reference would be obvious. As pointed out in the Appeal Brief, this is a curious position, not supported by *In re Gullack*. *In re Gullack* was followed by *In re Ngai*, 70 USPQ2d 1862 (Fed.Cir. 2004), a later Federal Circuit case, also dealing with

the issue of printed matter. *In re Ngai* explains and interprets *In re Gullack*, and any discussion of the earlier 1983 case that ignores the later 2004 case, ignores the development of the law in this area.

In the Examiner's Answer, the Examiner has indicated that "Appellant's arguments towards In re Ngai are also noted but this case and its particulars were not relied on in the action and therefore no further comment is provided here." The Examiner is apparently treating the citation of a Federal Circuit decision like the citation of a prior art reference. Apparently she feels that because the *In re Ngai* decision is not cited by the Examiner in the rejection, it is inappropriate for this decision to be discussed in relation to the rejection. This is not a proper approach to interpreting the substantive law in a particular area, and is clearly erroneous. The Examiner's rejection and citation of *In re Gullack* make relevant all case law in this substantive legal area, especially later cases that deal with the same or analogous issues as *In re Gullack*, and even more especially those later cases which explain *In re Gullack*. *In re Ngai* should not be ignored, and to do so would be clearly improper.

CONCLUSION

It is submitted that the claims pending in the instant application are allowable. Reversal of the final rejection of claims 1, 2, 4, 6, 13 and 15 in the Office Action of October 15, 2007 is respectfully requested.

Respectfully submitted,
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